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| | | | ART UNIT 2432 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOmail@beyerlaw.com

Office Action Summary

Application No.

10/596,864

Applicant(s)

AVRITCH ET AL.

Examiner

Cordelia Zecher

Art Unit

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 212, 214-227 and 229-239 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 212, 214-227 and 229-239 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the supplemental amendment filed on September 17, 2010. Claims 212, 214 – 227, 229 – 239 are pending. Claims 212, 227, 238 and 239 are independent.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 212, 214 – 227, 229 – 239 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 9 – 14, 18 – 20, 23 – 27, 32, and 41 – 43 of U.S. Patent No. 7,653,816 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claim of Patent '816 includes all the limitations of all of the independent claims of the current application.

4. Claims 1 – 27 of Application 12/632,655 contain every element of claims 212, 214 – 227, and 229 – 239 of the instant application and as such are not patentably distinct from the other application claims. While the claims are not identical, application '655 is only missing the limitation that the meta-data includes both the sender and receivers email addresses

5. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is

anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

6. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim). This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting" (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 212, 214 – 221, and 239 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al's US Patent 6,356,937, and further in view of Loh US Patent 7,574,737 B1.

11. Referring to claims 212 and 239, Montville teaches:

- a. By the service, receiving a request comprising meta-data information regarding the e-mail message (column 23, lines 53-58).
- b. By the service, processing at least a portion of the request to determine the result using a service private key, the service private key kept secret by the service (column 16, lines 14-27).
- c. By the service, providing the result for incorporation of the result into the e-mail message prior to the e-mail message being transmitted to a recipient of the e-mail message, as a result-incorporated e-mail message, via an e-mail system (column 16, lines 14-27).

12. Montville does not explicitly disclose the key being a service private key kept secret by the service, or the meta-data includes the email address of the sender and

receiver. However, Loh discloses that digital signatures are used (column 8, lines 36-38) and that the data security module adds the digital signature (column 8, line 67-column 9, line 1). Loh also teaches the meta-data regarding the email message includes at least an email address of a sender and receiver of the email message (column 12, lines 11-14). Montville and Loh are analogous art because they are from the same field of endeavor, secure communications. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Loh before him or her, to modify the system of Montville to include the communication module of Loh. The suggestion/motivation for doing so would have been to protect the privacy of communications that are intercepted by unauthorized users (column 8, lines 44-47).

13. Referring to claim 214, Montville teaches that the request includes a digest of the message body (column 8, lines 17-18).

14. Referring to claim 215, Montville teaches the digest is generated using a SHA algorithm (column 8, lines 29-31).

15. Referring to claim 216, Montville teaches that the request does not include the message body or information from which the message body can be derived (column 8, lines 17-21).

16. Referring to claim 217, Montville teaches the service determines the result to further include an indication of a level of certification of the email message (column 16, line 21, and column 7, lines 32-33).

17. Referring to claim 218, Montville teaches:

- d. The request comprises sender verification information (column 16, lines 6-9).
 - e. The processing of the verification information is obvious from the log-in and password steps. It would be obvious that the password would be verified before any further steps were taken.
18. Referring to claim 219, Montville teaches that the sender is associated with the email message and how to locate the sender at a later date (column 11, lines 6-10). The use of a driver's license or passport to prove the senders credentials means that the address of the sender would be included and therefor finding them at a later date would be obvious.
19. Referring to claim 220, Montville teaches associating a degree of certainty with the determination (column 11, lines 1-6).
20. Referring to claim 221, Montville teaches that the result includes an indication of the degree of certainty (column 7, lines 32-33). Since the certificate level is included in the email it is obvious.
21. Claims 222 – 225 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Loh in view of Heiner US Patent 6,112,227. Montville in view of Loh discloses all the limitations of the parent claim as well as the user having a plurality of email addresses (Montville, column 14, line 16). Montville in view of Loh does not appear to explicitly disclose using an inquiry message with the sender. However, Heiner discloses:

- f. Sending an inquiry message to the email address and observing the behavior of the sender (column 3, lines 46-48). (claim 222)
 - g. Sending a reply message back to the service (column 3, lines 47-48). (claim 223)
 - h. Including in the inquiry message a set of instructions (column 3, lines 59-60). (claim 224)
 - i. The instructions include a link to a particular URL or web page (column 4, lines 4-5). (claim 225)
22. Montville in view of Loh and Heiner are analogous art because they are from same field of endeavor, email certification. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Loh and Heiner before him or her, to modify Montville in view of Loh to include the inquiry messages and filtering of Heiner. The motivation for doing so would have been that junk mail is a known problem for users (column 1, lines 11-12) and this is an effective way to prevent unwanted emails(column 1, lines 57-60).
23. Claim 226 is rejected under 35 USC 103 (a) as being obvious over Montville in view of Loh in view of McKeon US Patent 5,926,552. Montville in view of Loh discloses all the limitations of the parent claim, as well as that the user is a subscriber (Montville, column 3, line 10). Montville in view of Loh does not appear to explicitly disclose how the subscriber joins the service. However, McKeon disclose the sender requesting to subscribe to the service then sending an inquiry message to the send via mail, then

observing how the sender handles the inquiry message (column 6, lines 7-16). Montville in view of Loh and McKeon are analogous art because they are from the same field of endeavor, certifying a subscriber. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Loh and McKeon before him or her, to modify Montville in view of Loh to include the terms of service of McKeon. The motivation for doing so would have been it makes the certification process more secure (McKeon, column 1, lines 62-64).

24. Claims 227, 229 – 234, and 238 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al's US Patent 6,356,937, in view of Loh US Patent 7,574,737 B1 and further in view of Scheidt et al's US Patent 6,490,680 B1.

25. Referring to claims 227 and 238, , Montville teaches:

- j. Receiving the e-mail message (column 16, lines 42-44).
- k. Processing a field of the received e-mail message using a public key of a service to generate a first result (column 16, lines 51-55).
- l. Processing a portion of the received e-mail message to generate a second result, the portion of the e-mail message including at least metadata information regarding the received e-mail message but not including the field of message processed to generate the first result (column 16, lines 51-55).
- m. Comparing the first result to the second result to assess the integrity of the received e-mail message (column 16, lines 51-55). Montville teaches verifying the integrity of the digital signature, which obviously includes decrypting the

digital signature and then comparing the decrypted digital signature with a hash of the received message.

26. Montville does not explicitly disclose the key being a service private key kept secret by the service, or the meta-data includes the email address of the sender and receiver. However, Loh discloses that digital signatures are used (column 8, lines 36-38) and that the data security module adds the digital signature (column 8, line 67-column 9, line 1). Loh also teaches the meta-data regarding the email message includes at least an email address of a sender and receiver of the email message (column 12, lines 11-14). Montville and Loh are analogous art because they are from the same field of endeavor, secure communications. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Loh before him or her, to modify the system of Montville to include the communication module of Loh. The suggestion/motivation for doing so would have been to protect the privacy of communications that are intercepted by unauthorized users (column 8, lines 44-47).

27. Montville does not explicitly disclose the digital signature being in the header. However, Scheidt discloses encrypting the hash of the object with a digital signature algorithm, and including the digital signature in the encrypted header (column 16, line 55-column 17, line 6). Montville in view of Loh and Scheidt are analogous art because they are from the same field of endeavor, secure communications. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Loh and Scheidt before him or her, to modify the

system of Montville in view of Loh to include the digital signature in the header Scheidt. The suggestion/motivation for doing so would have been to provide data authentication (column 6, lines 45-49).

28. Referring to claim 229, Montville teaches the portion of the email message processed to generate the second result includes a body of the received email message (column 8, lines 17-18).

29. Referring to claim 230, Montville teaches that the second result is a digest of a body of the received email message (column 8, lines 17-18).

30. Referring to claim 231, Montville teaches:

n. Deriving the portion of the request from which the result was determined column 16, lines 43-55).

o. Processing the portion of the request and the received email message to assess the integrity of the email message (column 16, lines 53-55).

31. Referring to claim 232, Montville teaches:

p. Processing the result using the service public key to generate a decrypted result (column 16, lines 53-55).

q. Generating a digest of the message body and processing the generated digest and the decrypt result to assess the integrity of the email message (column 16, lines 53-55).

32. Referring to claim 233, Montville teaches the service determines the result to further include an indication of a level of certification of the email message (column 16, line 21, and column 7, lines 32-33).

33. Referring to claim 234, Montville teaches that processing the received result to assess integrity is without interacting with a service that created the result having been incorporated into the email message (column 26, lines 56-66).

34. Claims 235 – 237 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Loh in view of Scheidt and further in view of Morkel US Publication 2002/0052921 A1. Montville in view of Loh in view of Scheidt discloses all the limitations of the parent claim. Montville in view of Loh in view of Scheidt does not appear to explicitly disclose providing contact information of the sender to the receiver. However, Morkel discloses:

r. Processing a request from the receiver to obtain contact information and then providing that contact information (page 1, paragraph 8). (claim 235)

s. It would be obvious that the email would be in a format appropriate for the client so that the requestor would be able to read the contact information. (claim 236)

t. A link to advertising information relative to the client (pages 3-4, paragraph 39). (claim 237)

35. Montville in view of Loh in view of Scheidt and Morkel are analogous art because they are from the same field of endeavor, processing emails. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Loh in view of Scheidt and Morkel before him or her, to

modify Montville in view of Loh in view of Scheidt to include the providing contact information of Morkel. The motivation for doing so would have been that peoples contact information changes frequently (Morkel, page 1, paragraph 3) and that contact information methods often lack security features to prevent unwanted access (Morkel, page 1, paragraph 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cordelia Zecher whose telephone number is (571)272-7771. The examiner can normally be reached on Monday - Thursday 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/C. Z./
Examiner, Art Unit 2432

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Primary Examiner, Art Unit 2432